

### **REMARKS**

Claims 1-12 are pending in this application. By this amendment, claims 1-2, 5, and 10-12 are being amended. Claims 1 and 2 are amended to more particularly point out that heat is applied to the metal surface after the overmoulding step. Claims 5, and 10-12 are being amended to place the claims in better form. No new matter is being added by this amendment.

### **Claim Rejections**

#### **Rejection Under 35 U.S.C. § 102**

##### **A. Response to Rejection of Claims 1-3, 5-6, and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Ricci et al.**

In response to the rejection of claims 1-3, 5-6 and 10-12 under 35 U.S.C. § 102(b) as being anticipated by International Patent Application No. WO 96/14533 of Ricci et al. ("Ricci"), Applicants respectfully submit that the reference does not teach all the elements of the presently claimed invention, and traverse the Rejection.

Applicants' invention relates to a process for affecting a coupling between a plastic material and a metal surface comprising the steps of:

- a) applying a powder of an adhesive polymer composition to the metal surface;
- b) overmoulding the metal surface with a plastic material by injection moulding; and  
following step b)
- c) applying heat to the metal surface.

In contrast, Ricci is directed to a process comprising the steps of:

1. applying an organic or inorganic primer to the metallic pipe or pipe fitting;

2. applying heat to the metallic pipe or fitting;
3. hot dipping the metallic pipe or pipe fitting;
4. introducing the hot dipped metallic pipe end or fitting into an injection moulding apparatus; then
5. overmoulding the metallic pipe or pipe fitting with a plastics material to effect said coupling. (page 3, lines 10-19)

The reference clearly does not teach or disclose Applicants' step c), where heat is applied to the overmoulded metal surface after the overmoulding step. Reconsideration and withdrawal of the Rejection respectfully is requested.

B. Response to Rejection of Claims 4, and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Ricci.

In response to the rejection of claims 4, and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Ricci, Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner and respectfully traverse the rejection.

With respect to the rejection under § 103, in order to establish a *prima facie* case of obviousness based on a single reference, the Examiner must establish all three of the following essential criteria: (1) there must be a motivation in the cited prior art to modify the reference as suggested by the Examiner; (2) the cited reference must teach or suggest each of the claimed elements; and (3) the cited reference must provide a basis for a reasonable expectation for success. The motivation to modify and the reasonable expectation for success must come from the cited prior art and not the Applicants' specification. Further, it is not enough that a reference

can be modified absent a suggestion in the cited prior art to undertake such modification.

As described above, the cited reference does not teach all the steps of the present invention because Ricci does not teach a heating step after the overmoulding step, as recited in the presently claimed invention. In fact, there is no disclosure of any treatment after molding in Ricci, so that there is no motivation in Ricci to modify its procedure to arrive at the process of the present invention, and no reasonable expectation for success. Therefore, since none of the essential criteria for a *prima facie* case of obviousness have been established, Applicants respectfully request that the Examiner reconsider and withdraw the § 103(a) rejection of claims 4, and 7-9, and allow those claims. Further, even if a *prima facie* case of obviousness could have been shown based on Ricci, Applicants have overcome any such *prima facie* case of obviousness by setting forth in the specification the advantageous enhanced peel strength resulting from the process of the invention, as summarized on page 6, lines 6-26. These unexpected and improved results provide yet further reason for withdrawal of the obviousness rejection.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have questions or comments regarding this application or this amendment, Applicants' attorney would welcome the opportunity to discuss the case with the Examiner.

It is not believed that any fee is required for entry and consideration of this Amendment; nevertheless, the Commissioner is hereby authorized to charge U.S. PTO Deposit Account 08-2336 in the amount of any such required fee.

This is intended to be a complete response to the Office Action mailed September 18, 2003.

Respectfully submitted,

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(Date)

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I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 9, 2003.

Alina A. Gupta  
October 9, 2003  
Date of Signature